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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,769	03/20/2001	Robert S. Oscar	746829-5	9298
22204 7590 04/03/2008 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128				
EXAMINER				
PORTER, RACHEL L				
ART UNIT		PAPER NUMBER		
3626				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/811,769

Applicant(s)

OSCAR ET AL.

Examiner

RACHEL L. PORTER

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 19-22, 32-35 and 40-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18, 23-31, 36-39, and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the election filed 8/15/07. Claims 1-54 are currently pending. Claims 1-13, 19-22, 32-35, and 40-48 are withdrawn from further consideration as per applicant's response to the restriction requirement. Claims 14-18, 23-31, 36-39 and 49-54 are rejected.

Drawings

2. The drawings are objected to because the poor contrast and small font in Figures 9, 11, and 12 renders the text illegible. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14-18, 23-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 14,23,24, 27,36,,37,52, and 55 recite limitations that are new matter, and are therefore rejected. The respective dependent claims inherit the deficiency through dependency and are therefore also rejected.

The added material which is not supported by the original disclosure is as follows:

- calculates out-of-pocket costs (means for calculating), sponsor costs, and total costs of the drugs dispensed to patients based upon the determined prescription benefit plan, the identified subscriber, the received claim information, the received formulary information, the received pharmacy benefits plan structure, and the received price information; and

- aggregates (means for aggregating) the out-of-pocket costs, sponsor costs, and total costs of the drugs dispensed to patients based upon at least one of identity of drug dispensed, type of drug dispensed, formulary information, identity of pharmacy dispensing drug, and identity of doctor prescribing drug;

In particular, the Applicant does not point to, nor was the Examiner able to find, any support for this newly added claim language within the specification as originally filed. As such, the Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims, or to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-18, 23-31 are rejected under 35 U.S.C. 103(a) as being obvious over Pack-Harris (USPN 6,195,612) in view of Mayaud (USPN 5,845,255)

[claim 14] Pack-Harris discloses a pharmacy benefits management server comprising:

- means for downloading information from a processor server having claim information relating to pharmacy benefits claims processed by a claims

processing facility, said claim information including identification of drugs dispensed to patients; (Figure 1, col. 3, lines 55-col. 4, line 4; col. 4, lines 14-26)

- means for downloading pharmacy benefits plan structure information stored therein; (col. 4, lines 27-32)
- means for downloading price information relating to drugs in various classes stored therein; and (Figure 18-19)
- means for correlating the claim information with the benefits plan structure information, the price information, and, alternative drugs in the same class as the selected drugs, and expenses associated with the alternative drugs. (Figure 3, Fig. 5, col. 35-59)

Pack-Harris discloses the system as disclosed above, but does not expressly disclose providing pharmacy benefits formulary information. Mayaud discloses a method wherein pharmacy benefits formulary information is transmitting and provided in a pharmacy system. (col. 13, lines 49-61; col. 14, lines 10-19) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits data in a pharmacy system. As suggested by Mayaud, one would have been motivated to include this feature to encourage better formulary prescription compliance and reduce health-care costs. (col. 13, lines 49-61)

[claims 15] Pack-Harris discloses a server as recited in claim 14, wherein the selected drugs are drugs previously dispensed to a patient. (Figures 8 and 32; col. 6, lines 37-54)

[claim 16] Pack-Harris discloses a server as recited in claim 14, wherein the alternative drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 17] Pack-Harris discloses a server wherein the benefits plan structure information (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives)) and the formulary information relate to a multi-tier benefits plan.

[claim 18] Pack-Harris discloses a server as recited in claim wherein the expenses associated and the expenses associated with the alternative drugs includes copayment information and total cost information. (col. 5, lines 35-59; Figure 33)

[claim 23] Pack Harris discloses a server wherein the alternative drugs are therapeutic alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 24] Pack -Harris discloses a server, wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 25] Pack-Harris discloses a server as recited in claim 14 further comprising means for entering proposed changes to any of the claim information, the benefit plan structure information, and the formulary information and displaying model data based on the proposed changes. (Figure 1; col. 3, lines 10-45; lines 55-col. 7, line 4)

[claim 26] Pack-Harris discloses a server as recited in claim 25, wherein the proposed changes comprise any of changes to copayment amounts, changes to copayment levels, and changes drugs dispensed. (col. 4, lines 33-67)

[claim 27] Pack-Harris teaches a pharmacy benefits management method comprising the steps of.

- downloading claim information relating to pharmacy benefits claims processed by a claims processing facility, said claim information including identification of drugs dispensed to patients; (Figure 1, col. 3, lines 55-col. 4, line 4; col. 4, lines 14-26)
- downloading pharmacy benefits plan structure information; (col. 4, lines 27-32)
- downloading price information relating to drugs in various classes; and (Figure 18-19)
- correlating the claim information with the benefits plan structure information, the price information to identify drugs expenses associated with selected drugs in accordance with the pharmacy benefits plan structure information, alternative drugs in the same class as the selected drugs, and expenses associated with the alternative drugs. (Figure 3, Fig. 5, col. 35-59)

Pack-Harris discloses the method as disclosed above, but does not expressly disclose providing pharmacy benefits formulary information. Mayaud discloses a method wherein pharmacy benefits formulary information is transmitting and provided in a pharmacy system. (col. 13, lines 49-61; col. 14, lines 10-19) At the time of the

Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Pack-Harris with the teaching of Mayaud to provide/transmit formulary benefits data in a pharmacy system. As suggested by Mayaud, one would have been motivated to include this feature to encourage better formulary prescription compliance and reduce health-care costs. (col. 13, lines 49-61)

[claim 28] Pack-Harris teaches a method wherein the selected drugs in said correlating step are drugs previously dispensed to a patient (Figures 8 and 32; col. 6, lines 37-54)

[claim 29] Pack-Harris teaches a method, wherein the alternative drugs in said correlating step are therapeutic alternatives with respect to the selected drugs. (Figure 4 (brand vs. generic))

[claim 30] Pack-Harris and Mayaud in combination teach a method wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 31] Pack-Harris teaches a method as recited in claim 30, wherein the expenses associated and the expenses associated with the alternative drugs includes copayment information and total cost information. (col. 5, lines 35-59; Figure 33)

[claim 36] Pack-Harris teaches a method, wherein the alternative drugs are therapeutic

alternatives with respect to the selected drugs. (Figure 3, Figure 4 (brand vs. generic reports, col. 5, lines 35-45))

[claim 37] Pack-Harris and Mayaud in combination disclose a method, wherein the benefits plan structure information and the formulary information relate to a multi-tier benefits plan. (Fig. 26 (commercial, senior,) 34(e.g. non-covered lives))

[claim 38] Pack-Harris and Mayaud in combination disclose a method further comprising the step of permitting entry of proposed changes to any of the claim information, the benefit plan structure information, and the formulary information; (col. 3, line 55-col. 4, line 67) and displaying model data based on the proposed changes. (Figure 3, col. 5, lines 35-67)

[claim 39] The limitations of claim 39 are addressed by the rejection of claims 26 and 38.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/Robert Morgan/
Primary Examiner, Art Unit 3626